

U.S. Application No.: 09/715,641

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REMARKS

The Applicants have carefully reviewed and considered the current Office Action and the reference(s) cited therein. No claims are herein amended; no claims are herein canceled; and Claims 29-31 are herein added. As a result, Claims 1-16 and 18-31 are now pending in this application.

The Applicants thank the Examiner for the courtesy of a telephone interview on December 10, 2007. During the telephone interview, it was discovered that the Examiner and the Applicants differ as to their interpretations of the teachings of U.S. Patent No. 6,507,866 issued to Barchi ("Barchi"). The Applicants contend that the methods taught in Barchi are performed only on received messages (on the "receiving side"), such as received by a receiver-SMTP server, and are not performed on outbound messages (on the "sending side"), as required by the present claims. The Examiner, on the other hand, contends that Barchi is performed on the sending side. Applicants have agreed to herein include whatever arguments and cites to Barchi that the Applicants believe indicate that Barchi is performed only on the receiving side.

Rejection of Claims 1-16 and 18-28 under 35 U.S.C. §103

The Examiner has rejected Claims 1-16 and 18-28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0233420 issued to Stark et al. ("Stark") in view of Barchi. Applicants respectfully traverse this rejection.

The Applicants contend that Stark and Barchi are not properly combinable. First, Barchi teaches away from the present invention. Barchi teaches identifying "undesired e-mail messages by receiving e-mail messages, storing fields including at least one field from the header of each received e-mail message and analyzing the stored fields for a least one pattern indicative of undesired e-mail messages." *Barchi* at col. 4, lines 58-67. Barchi teaches that received emails contain headers that are created when "a sender-SMTP establishes a two-way transmission channel with a receiver-SMTP." *Id.* at col. 1, line 26 to col. 2, line 23. Barchi teaches methods that extract information from headers in incoming e-mail messages (i.e., received e-mail messages). See, for e.g., *Id.* at col. 6, line 7-8 ("For example, fields from the 821 header and/or the 822 header may be extracted in the Hunt Mode."). Accordingly, Barchi teaches operating on

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received e-mails only after a two-way transmission channel with a receiver-SMTP is established and the headers having the extractable information are created.

The present invention, on the other hand, operates on outbound messages. The present invention, as a whole, has the benefit of not having to open up two-way transmissions to those recipients that exceed a message limit associated with the originator identity. Transmission only occurs to those recipients that do not exceed the message limit.

Second, changing Barchi to operate on the sending side would destroy some of the purpose and functionality of Barchi. Barchi teaches protecting "the receiving e-mail system not only against malicious users, but also against such events as routing accidents." *Id.* at col. 5, line 64 to col. 6, line 3. Barchi can only protect against routing accidents if the mechanism is employed at the receiving end, after emails have been routed (i.e., transmitted). The present invention, although providing benefits absent in Barchi, does not provide protection against routing accidents. This is because the present invention operates at the sending end, before emails are transmitted or routed. The present invention can reduce the number of emails routed by checking message limits associated with an originator identity and only routing those messages that are under the limit. However, once an email is transmitted in accordance with the present invention, any routing accidents can only be dealt with at the receiving end.

Attempting to operate the methods in Barchi at the sending end would eliminate the ability of Barchi to protect against routing accidents, effectively destroying at least some of the purpose of Barchi. One of ordinary skill in the art at the time of the present invention would have no motivation to combine Barchi with any art (e.g., Stark) if the resulting combination would destroy some or all of the benefits of Barchi.

Barchi also teaches detecting large numbers of e-mail messages sent to a single recipient. *Id.* at col. 7, lines 14-16 ("For example, for a list maintained for purposes of identifying undesired use in the form of many originators sending e-mail messages to a single recipient."). See also, *Id.* FIG. 6 and accompanying text ("The logic shown in FIG. 6 checks for whether the number of e-mail messages to a single recipient has exceeded predetermined threshold."). If Barchi is to be capable of counting all

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originators sending e-mail to a particular recipient, then Barchi must be operating at the recipient. If Barchi were moved to the sending side, then Barchi would only see messages intended to be sent to the particular recipient that originated at the sending-side server. Since it is well known in the art that there exist many sending-side email servers, Barchi, operating on a sending-side server, would only see a small fraction of the e-mails sent to the particular recipient, again defeating one of the purposes of Barchi.

Conclusion

Applicants contend that it would not have been obvious to one of ordinary skill in the art at the time of the present invention to combine Barchi with Stark as suggested by the Examiner. The Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. If the Examiner believes that a telephone conversation with the Applicants' representative would facilitate prosecution of this application in any way, the Examiner is cordially invited to telephone the undersigned at (508) 616-9660.

Respectfully submitted,

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Stanley K. Hill, Esq.
Attorney for Applicant(s)
Registration No.: 37,548
Chapin Intellectual Property Law, LLC
Westborough Office Park
1700 West Park Drive
Westborough, Massachusetts 01581
Telephone: (508) 616-9660
Facsimile: (508) 616-9661